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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/691,624 | 10/24/2003 | Joachim Brendel | 02481.1687-03 | 8262 |
| 5487 | 7590 | 11/24/2004 | EXAMINER | |
| ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807 | | | DESAI, RITA J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1625 | |
| DATE MAILED: 11/24/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,624

Applicant(s)

BRENDAL ET AL.

Examiner

Rita J. Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 15-19 in part, drawn to compounds and pharmaceutical compositions wherein R1 is as given in claim 18, wherein all the Rs are non-hetero ring or group containing and R30 and R31 do not form a ring classified in class 564 and various subclasses. A further election of a single disclosed species is required.
- II. Claims 1-8, 15-19 in part, drawn to compounds and composition wherein R1 is other than in group I and R14 is a hetero group, furyl or thienyl and R30 and R31 do not form a ring, classified in class 548, 549 and various subclasses. A further election of a single disclosed species is required.
- III. Claims 1-8, 15-19 in part, drawn to compounds and compositions wherein R30 and R31 form a ring and there are no other hetero rings or groups in the R's, classified in class 564 and various subclasses. A further election of a single disclosed species is required.
- IV. Claims 1-8, 15-19 in part, drawn to compounds and compositions wherein R3 and R31 do form a ring and R14 is a hetero ring containing group, classified in class 548, 549 and various subclasses. A further election of a single disclosed species is required.
- V. Claims 1-8, 15-19 in part, drawn to compounds and compositions wherein R1-R31 are different than those given in the above groups classified in different

classes and subclasses. A further election of a single disclosed species is required.

- VI. Claims 9-14, drawn to different methods of treating the various diseases as listed, classified in class 514 and various subclasses.

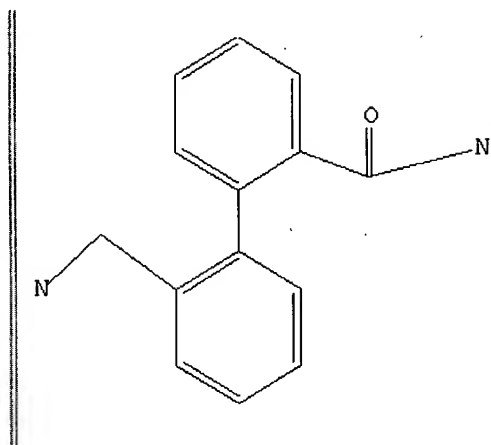
The inventions are distinct, each from the other because of the following reasons:

Inventions I-V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of treating the various diseases can be carried out by other drugs, some of which are on the market too.

Inventions I to V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have a different core structure and the core is not a contribution over the prior art. Hence they are patentably distinct.

When the core was screen searched

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a number of iteration werthe obtained indicating that the core is not novel.

See below.

SAMPLE SEARCH INITIATED 18:32:57 FILE 'REGISTRY'
SAMPLE SCREEN SEARCH COMPLETED - 433 TO ITERATE

100.0% PROCESSED 433 ITERATIONS 50 ANSWERS
INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)
SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE **COMPLETE**
BATCH **COMPLETE**
PROJECTED ITERATIONS: 7412 TO 9908

Thus restriction is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-VI, restriction for examination purposes as indicated is proper.

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A telephone call was made to Mr. Raymond Parker on 11/29/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "R. Desai", with a horizontal line drawn underneath the name.

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
November 22, 2004

11/22/04